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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,105	05/22/2001	Beth Louise Hoffman	ROC920010048US1	9207

7590 07/27/2004
Dugan & Dugan, L.L.P.
18 John Street
Tarrytown, NY 10591

EXAMINER

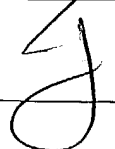
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,105	Applicant(s) HOFFMAN ET AL.	
	Examiner Igor Borissov	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

Applicants amendment received 04/16/2004 is acknowledged and entered. Claims 1-52 have been cancelled. New claims 53-57 have been entered. Currently, claims 53-57 are pending for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 53 is rejected under 35 U.S.C. 102(e) as being anticipated by O'Hagan et al. (US 6,595,417) (hereinafter O'Hagan).

O'Hagan teaches an electronic shopping method and system, comprising:
Claim 53.

entering product codes (shopping list) from a portable computing device to a computer (C. 3, L. 25-30);

retrieving product location information for entered product codes (column 3, lines 35-40; column 19, lines 5-10);

presenting the retrieved product location information to the customer (column 3, lines 35-40);

determining customer location in the store (C. 12, L. 6-15);

promoting products not included in the shopping list based on the customer's location in the store (C. 15, L. 28-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan in view of Powell (US 5,887,271).

Claim 54. O'Hagan teaches:

entering product codes (shopping list) from a portable computing device to a computer (C. 3, L. 25-30), which obviously indicates entering quantity of items of the shopping list;

retrieving product location information for entered product codes (C. 3, L. 35-40; C. 19, L. 5-10);

presenting the retrieved product location information to the customer (C. 3, L. 35-40).

O'Hagan does not teach printing the retrieved product location information and quantity of items of the shopping list.

Powell teaches a method and system for locating products in a retail system, including a kiosk containing an Internet connected computer, via which product codes are entered (column 5, lines 28-40), and a printer for printing product location information and other product related information (C. 5, L. 37-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan to include printing the retrieved product location information and other product related information, as disclosed in Powell, because it would provide less expensive product locating system, thereby make it more attractive to small stores. Information as to printing *quantity of items* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-

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obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in O'Hagan and Powell would be performed the same regardless of the content of product-related information being printed.

Claim 55. O'Hagan teaches:

entering product codes (shopping list) from a portable computing device to a computer (C. 3, L. 25-30), which is obviously indicates entering quantity of items of the shopping list;

retrieving product location information for entered product codes (column 3, lines 35-40; column 19, lines 5-10);

presenting the retrieved product location information to the customer (column 3, lines 35-40);

indicating availability of the specific product requested by the customer (C. 20, L. 54-58).

O'Hagan does not teach printing the information related to the location of the retrieved product and availability of the requested product.

Powell teaches a method and system for locating products in a retail system, including a kiosk containing an Internet connected computer, via which product codes are entered (column 5, lines 28-40), and a printer for printing product location information and other product related information (C. 5, L. 37-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan to include printing the retrieved product location information and other product related information, as disclosed in Powell, because it would provide less expensive product locating system, thereby make it more attractive to small stores. Information as to printing *information related to availability of the*

requested product is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 56. O'Hagan teaches: upon entering a desired product code by the customer, providing the customer with a list of all products available in the store (C. 18, L. 60-66), thereby obviously indicating providing *alternative* product.

Claim 57. O'Hagan teaches:

entering product codes (shopping list) from a portable computing device to a computer (C. 3, L. 25-30), which is obviously indicates entering quantity of items of the shopping list;

retrieving product location information for entered product codes (C. 3, L. 35-40; C. 19, L. 5-10);

presenting the retrieved product location information to the customer (C. 3, L. 35-40).

O'Hagan does not teach printing the retrieved product location information and comparison shopping information.

Powell teaches a method and system for locating products in a retail system, including a kiosk containing an Internet connected computer, via which product codes are entered (C. 5, L. 28-40), and a printer for printing product location information and other product related information (C. 5, L. 37-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan to include printing the retrieved product location information and other product related information, as disclosed in Powell, because it would provide less expensive product locating system, thereby make it more attractive to small stores. Information as to printing *comparison shopping information* is non-functional language and given no patentable weight. Non-functional descriptive material

cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Response to Arguments

Applicant's arguments filed 04/16/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that the cited prior art ~~dose~~^{es} not teach: determining customer location in the store, the examiner stipulates that O'Hagan does teach this feature (See: C. 12, L. 6-15; and discussion above).

In response to the applicant's argument that the cited prior art dose not teach: promoting products not included in the shopping list based on the customer's location in the store, the examiner points out that O'Hagan specifically disclose this feature (See: C. 15, L. 28-41; and discussion above).

In response to the applicant's argument that the cited prior art dose not teach: printing product-related information, the examiner points out that O'Hagan in view of Powell teach this feature (See, Powell, C. 5, L. 37-40; and discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

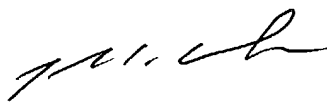
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600